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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/720,584	12/22/2000	Takeshi Kubota	TJK/149	2399

26689 7590 05/24/2004

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EXAMINER	
NORDMEYER, PATRICIA L	
ART UNIT	**PAPER NUMBER**
1772	

DATE MAILED: 05/24/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/720,584	KUBOTA, TAKESHI	
	Examiner	Art Unit	
	Patricia L. Nordmeyer	1772	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *23 February 2004*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *3-5* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *4 and 5* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☒ Claim(s) *3* are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Repeated Rejections

1. The 35 U.S.C. 103 rejection of claims 4 and 5 over Benson et al. (USPN 5,696,627) is repeated for reasons previously of record in the paper dated September 23, 2003.

Benson et al. discloses a shape sheet with having a convex-concave pattern formed on the releasable layer, where the top and bottom portions of the convex-concave pattern have flat cross-sectional shapes with irregular surfaces (Figure 18) and a second layer that acts as a substrate (Column 8, lines 44 – 46 and Figure 8, #48). The sheet is made from a variety of materials including thermoplastic or thermoset materials (Column 9, lines 53 – 56) and other transparent materials (Column 17, lines 52 – 64). A height difference of 12.7 microns exists between the two portions (Column 10, lines 57 – 61). The roughness of the irregularities on the surfaces is dependent on the width of the grooves in the surface, where the width is optimized to tailor the optical performance of the article (Column 11, lines 4 – 20); therefore, it would be obvious to one of ordinary skill in the art to have a roughness between 1.5 and 30 μm on the surface of the article in order to have the optimum optical performance.

The limitation of the forming a resin coating having a convex-concave pattern by casting from a solution of a reactive or thermoplastic resin or a thermally molten composition in claim 4 is a process limitation. The determination of patentability for a product claim with a process limitation is based on the product itself and not on the method of production. In this case, the

limitation of forming a resin coating having the convex-concave pattern is a method of production and therefore does not determine the patentability of the product itself. The method of forming the product is not germane to the issue of patentability of the product itself. MPEP 2113.

Response to Arguments

2. Applicant's arguments filed February 23, 2004 have been fully considered but they are not persuasive.

In response to Applicant's argument that Benson et al. fail to specify a surface roughness for the cube corner articles and therefore it would be impossible to say the performance of the article is degraded or optimized, Benson et al. clearly state that the article is highly tailorable to optimize the optical performance (Column 11, lines 4 – 20). During the manipulation the surface, the range of 1.5 to 30 μm disclosed in the claimed invention may be selected as the optimized surface. Therefore, one of ordinary skill in the art could readily determine the optimum roughness of the surface depending on the desired end result and in the absence of unexpected results. It is up to the Applicant to show that the surface roughness carries unexpected results.

Conclusion

3. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Patricia L. Nordmeyer whose telephone number is (571) 272-1496. The examiner can normally be reached on Mon.-Thurs. from 7:00-4:30 & alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Y. Pyon can be reached on (571) 272-1498. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Patricia L. Nordmeyer
Examiner
Art Unit 1772

pln

HAROLD PYON
SUPERVISORY PATENT EXAMINER
1772

5/19/04